

REMARKS

At the time of the Office Action dated November 17, 2003, claims 1-13 were pending, all of which stand rejected.

Applicants acknowledge, with appreciation, Examiner Vu's and Examiner Hu's courtesy and professionalism in conducting an interview on December 22, 2003. It is Applicants' understanding that the present Amendment would overcome the present rejections if the invention is clearly defined in the claims.

In this Amendment, claims 1-3, 5-7, 9-11 and 13 have been amended to clarify the relationship among the claimed elements, e.g., an orientation of a die with respect to a die pad, and an orientation of a sealing member with respect to the die. New claims 14-20 have also been added based on Fig. 7 and relevant description of the specification. Care has been exercised to avoid the introduction of new matter.

Based on this Amendment, Applicants submit that the invention is clearly defined in the claims and respectfully request the Examiner to consider the following differences between the claimed invention and the cited references.

Claims 1, 2 and 4 have been rejected under 35 U.S.C. §102(e) as being anticipated by Glenn.

In the statement of the rejection, the Examiner asserted that Glenn discloses a stackable package having cavity and a lid for an electronic device, identically corresponding to what is claimed. However, Applicants submit that Glenn does not disclose a semiconductor package containing all the limitations recited in **claim 1** as amended. Specifically, Glenn does not disclose the limitation "the outer leads extend at least from a plane including the lower surface of

the sealing member to beyond that of the uppermost surface of the sealing member,” recited in claim 1.

Fig. 3 of Glenn discloses a key 15 provided on a first surface 12 of a package body 11. It can be said that a surface of the key 15 is an uppermost surface of the package body 11, relative to the first surface 12. Even so, leads 21 of Glenn do not extend at least from a plane including a second surface 13 of the package body 11 to beyond that of the uppermost surface of the package body 15.

Therefore, Glenn fails to identically describe a semiconductor package including the outer leads as claimed in claim 1 within the meaning of 35 U.S.C. §102. Applicants, therefore, respectfully solicit withdrawal of the rejection of claim 1.

A dependent claim is not anticipated if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claim. Therefore, **claims 2 and 4** are patentable because they respectively include all the limitations of independent claim 1. The Examiner's additional comments with respect to claims 2 and 4 do not cure the argued fundamental deficiencies of Glenn. Specifically, Glenn does not disclose the limitation “the outer leads are formed in an L-shape,” recited in claim 4. Glenn discloses that “Leads 21 include two approximately 90° bends so as to have a C-shape” (column 4, lines 4-5). Applicants respectfully solicit withdrawal of the rejection of claims 2 and 4.

Claims 3 and 5-12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Glenn.

In the statement of the rejection, the Examiner asserted that the claimed invention would have been obvious over Glenn.

With respect to independent **claim 5**, Applicants submit that Glenn does not disclose a semiconductor package having the outer leads extending “at least from a plane including the lower surface of the sealing member to beyond that of the uppermost surface of the sealing member,” as discussed for claim 1.

For **claim 9**, Applicants submits that Glenn in Figs. 2 and 3 does not disclose a semiconductor package including the limitation “each semiconductor package having an upper surface of a sealing member thereof facing the printed wiring board.” According to claim 9, the first and second surfaces 12 and 13 of Glenn correspond to the upper and lower surfaces of the sealing member of the claimed invention, respectively. However, the first surface 12 of Glenn does not face a printed circuit board 31, but faces the second surface (lower surface) 13 of another package 10.

Thus, Glenn would not have suggested each and every limitation of amended claims 5 and 9. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicants, therefore, solicit withdrawal of the rejection of claims 5 and 9.

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, as claims 5 and 9 are patentable for the reasons set forth above, it is submitted that dependent **claims 6-8 and 10-12** which respectively depend from claims 5 and 9 are also patentable. It is also submitted that claim 3 is patentable because it includes all the limitations recited in independent claim 1 which is not anticipated by Glenn. The Examiner’s additional comments with respect to the claims do not cure the argued fundamental deficiencies of Glenn.

Specifically, Glenn does not teach or suggest the limitation “the outer leads are formed in an L-shape,” recited in claim 8 and 12. As mentioned above, Glenn discloses that “Leads 21

include two approximately 90° bends so as to have a C-shape” (column 4, lines 4-5). Because the leads 21 have such a shape, the height of a package of Glenn is determined by $A + 2t$ (A = a thickness of the sealing member (package body 11), t = a thickness of the outer lead) (see an attached sheet). On the other hand, since each outer lead has a L-shape, the height of a package of the claimed invention is determined by $A + t$ (not $2t$) (see also the attached sheet). Each lead of the claimed invention does not include two approximately 90° bends, but only one bent. As a result of this difference, the claimed invention has a benefit that the package of the claimed invention can reduce its height by a thickness of the outer lead, as compared to Glenn’s package. In addition, a connection of the outer lead of the claimed invention to another outer lead is easy to made properly, when a plurality of the packages are stacked up on a printed wiring board as claimed in claims 5. This is so because a solder fillet is formed between the outer leads.

Applicants, therefore, respectfully solicit withdrawal of the rejection of claims 3, 6-8 and 10-12.

Claim 13 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Glenn in view of Nagesh et al.

In the statement of the rejection, the Examiner asserted that claim 13 would have been obvious over the proposed combination of Glenn and Nagesh et al.

As discussed above, as claim 9 is patentable for the reasons set forth above, it is submitted that dependent claim 13 which depends from claim 9 is also patentable. *See In re Fine, supra*. In addition, Nagesh et al. is completely silent on the limitation “each of the semiconductor packages is arranged to be mounted on the printed wiring board such that the

upper surface of the sealing member faces the printed wiring board,” recited in claim 9. Applicants, therefore, respectfully solicit withdrawal of the rejection of claim 13.

New Claims 14-20.

Claims 14 includes the limitation “each semiconductor package having an upper surface of a sealing member thereof facing the printed wiring board,” recited in claim 9. Further, claims 15-20 respectively recite the limitation “the outer leads extend at least from a plane including the lower surface of the sealing member to beyond that of the uppermost surface of the sealing member.” As discussed above, the prior art of record does not teach or suggest this limitation. Therefore, Applicants solicit favorable consideration for new claims 14-20.

Conclusion.

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

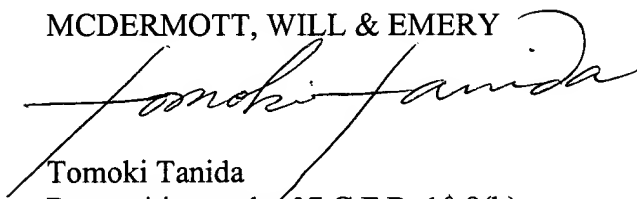
To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

09/915,366

including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in cursive script, appearing to read "Tomoki Tanida", written over a horizontal line.

Tomoki Tanida

Recognition under 37 C.F.R. 10.9(b)

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 SAB:TT:lnm
Facsimile: (202) 756-8087
Date: February 17, 2004